

REMARKS

Status of Claims

Claims 8-14 and 22 are currently pending in the application. Claims 12 and 13 have been allowed. Claims 11 and 14 are objected to.

At paragraph 4 of the Action, the Examiner has objected to Claim 8, because "...claimed variable R¹ is not defined in proper Markush format." The Examiner suggested that this objection would be overcome by: a) insertion of the word "and" between options (d) and (e); and deleting the word "and" following option (e).

Applicants have inserted "and" as suggested by the Examiner. Applicants respectfully submit that the "and" following option (e) was deleted (struck through) in the amendment filed October 24, 2007. Finally, note that Applicants corrected the choice ordering to read (a), (b), (c) and (d).

At paragraph 5 of the Action, the Examiner has objected to claim 11 because "...the claim does not end in a period". Applicants have amended Claim 11 as indicated. Once again, Applicants note that they have corrected the choice ordering of R1 to read (a), (b), (c) and (d).

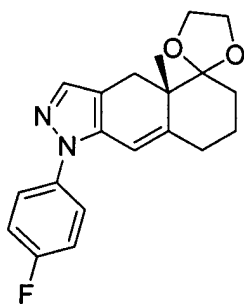
At paragraph 6 of the Action, the Examiner has objected to Claim 14 because "...the claim is not written in proper alternative or Markush format." The Examiner suggested that this objection would be overcome by inserting "and" or "or" on page 28 before the identifier "viii)". Applicants have amended Claim 14 at the point required by inserting "and".

At page 8-10, 22, 28 and 29 are rejected under 35 USC 102(e) as anticipated. The Examiner states:

"7. Claims 8-10, 22, 28 and 29 rejected under 35 U.S.C. 102(e) as being anticipated by the following three references: A) Ali et al. (WO 04/075840; step 3 on p. 37); b) Ali et al. (WO 04/026248, step c on p. 39); c) Ali et al. (WO 2003/086294, step 3 on p. 43).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. (e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention 'by another,' or by an appropriate showing under 37 CFR 1.131.

The three references teach the compound shown below in a composition comprising 40 mL of acetic acid in 1 L of water (ie. Aqueous solution).



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Applicants respectfully disagree with the Examiner's analysis. The composition referred to be the Examiner cannot be construed to be a pharmaceutical composition. It is a compound (indeed an intermediate) in a strong acid solution. Nonetheless, in order to advance the prosecution of this case, applicants have amended the claims in question to exclude (proviso out) the species in question. Support for this amendment is found at, for example, page 38 of the application (see Example 138).

Applicants respectfully submit that their amendment to the claims fully address the Examiner's concerns. In particular, Applicants amendments to claim 8 render claims 8 to 10 allowable. Applicants' amendments to claim 11 render claims 11 to 13 and 22 allowable. [Note that claims 12 and 13 were already allowed.] Applicants' amendments to claim 14 render claim 14 allowable.

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Applicants submit that the application is in condition for allowance and passage thereto is earnestly requested. Any additional fees required in connection with this Amendment may be taken from Merck Deposit Account No. 13-2755. The Examiner is invited to contact the undersigned attorney at the telephone number provided below if such would advance the prosecution of the case.

Respectfully submitted,

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